

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: : Group Art Unit: 1762
Paul J. Glatkowski et al. :
App. No.: 10/729,369 : Examiner: Alain L. Bashore
Filed: December 8, 2003 : Confirmation No. 8141
Title: OPTICALLY TRANSPARENT NANOSTRUCTURED ELECTRICAL
CONDUCTORS

MAIL STOP: AMENDMENT

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action, mail dated June 11, 2007, Applicant respectfully makes the following provisional election and requests reconsideration of the restriction requirement in view of Applicant's remarks below.

Remarks Regarding Restriction Requirement

In the Office Action, restriction is alleged to be required, under 35 U.S.C. § 121, to one of the following groups of claims:

Group I: Claims 18-25, 33 and 34; drawn to a method in class 427, subclass 256;
and

Group II: Claims 1-17 and 26-32 drawn to a product in class 428, subclass 297.4.

Applicant provisionally elects Group II, claims 1-17 and 26-32, with traverse.

As recited under M.P.E.P. 803, restriction is appropriate only when the groups can be shown to be distinct and there would be a "serious burden" placed on the Examiner to examine more than one group of claims. No such serious burden has been established and applicant respectfully requests that this restriction be withdrawn.

Applicant respectfully asserts that the two groups identified are directed to optically transparent carbon nanotubes structures. Accordingly, it would appear that a search of one group would necessarily include a search of all other groups. An increased searching burden

is not apparent. The examiner's comments in the Office Action add nothing to support an increased searching burden, but merely recite statements from the Manual of Patent Examining Procedure ("MPEP"). Merely reciting text from the MPEP does not meet the burden of establishing a *prima facie* case for restriction. Why an increased search burden exists for each of the species is unclear and, thus, a *prima facie* case for a restriction requirement has not been met.

A restriction requirement is imposed "only" when it would be a serious burden on the examiner to examine all of the claims at once. No serious searching burden has been established and, thus, the burden to impose the restriction has not been met and remains with the PTO. Withdrawal of the restriction and examination of all claim groups is respectfully requested.

Applicant respectfully notes that the Office Action states that a species election must be made (see Office Action, page 3), but no species were identified and none were discussed in the Examiner's comments. Applicant believes the comments in the Office Action to be a typographical error and that no species restriction has been imposed.

CONCLUSION

Should any fees be necessary in connection with the filing of this Response, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge **Deposit Account No. 14-1437 for any such fees, referencing Attorney Docket No. 8125.012.US**; and Applicant hereby petitions for any needed extension of time not otherwise accounted for with this submission.

Date: July 11, 2007

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Respectfully submitted,
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